

REMARKS/ARGUMENTS

The Official Action has been carefully considered and the Examiner's comments are duly noted. Reconsideration of this Application in light of the additional amendments for the Claims and Arguments is respectfully solicited.

The Claims 1 to 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiyama JP 09098227 A in view of Skigin et al (RU Patent 2,105,425).

In accordance with Paragraph No. 4, the Applicant's arguments with respect to claims 1 to 12 were considered but are moot in view of the new grounds of rejection according to the Examiner. Therefore, it is safe to assume that the Examiner does not consider Frantz U.S. Patent 6,167,043 or Kikinis U.S. Patent 6,339,593 or Stovall U.S. Patent 6,144,724 or Foley U.S. Patent 6,069,899 or Riemann et al. ET 0829995 or Baratz U.S. Patent 5,742, 596 to be used in connection with the rejection of this Application and therefore the argument will be restricted to the newly cited reasons for rejection on the basis of the combination of references rejections consisting of Hiyama- JP 09098227 A in view of Skigin et al. (RU Patent 2,105,425).

Some of the claims have been amended from the point of view to bring out more clearly the various functions of the structure set forth in order to provide for the present argument.

Claim 1 has been amended so as to set forth that the telephone network is restricted to the features set forth within the body of claim 1 and further that the telephone sets are connected directly to the telephone network and further that the computer telephony server is connected directly to the bus so that as set forth in the

whereby clause, that the telephone sets can communicate with each other without the necessity of computers by the telephone sets connected to the local computer network.

This claim 1 clearly distinguishes the invention from all of the references of record whether it be Baratz or Hiyama or any other combination of references with Skigin et al.

Claim 5 which is another independent claim has been amended to set forth the whereby clause noted heretofore. In addition, for the sake of emphasis, claim 6 has been amended so as to set forth that the network is free of specialized switching devices. This is clearly another feature of the invention which is not shown nor suggested by any of the references with respect to the combination of features claimed in claim 6.

Claim 9 which is another independent claim has been amended so as to set forth the whereby clause to set forth the features accomplished by the particular structure.

Since this is the first time since Applicant has been made aware of the Hiyama Japanese Patent and its combination of references with Skigin, the Examiner is respectfully solicited to allow amendments of the claims should this be necessary, and if further amendment should be necessary the Examiner is respectfully asked to allow such further amendments.

With respect to claim 2, and the Examiner's comments about to allow direct voice telephone communication, it is not understood whether the Examiner is interpreting this as meaning a direct connection or in some respects there is a connection to the feature. Nevertheless, the Examiner is respectfully asked to consider the limitation "directly" which appears in all of the claims. It is submitted that this term answers the Examiner's statement as best understood with respect to Hiyama.

With respect to claim 3, while Applicant disagrees with the Examiner's interpretation as to what Hiyama's application discloses, assuming *arguendo* that the Examiner is correct, which does not appear to be so to the Applicant, and Applicant does not concede the correctness of the Examiner's argument, it should be noted that there is no motivation nor suggestion nor any teaching in Skigin to explain how Hiyama could be combined with Skigin. Further, a careful analysis of Hiyama does not show any motivation or suggestion as to how the subject matter of Skigin can be combined with Hiyama. The same applies for claims 7 and 10.

Regarding the argument about direct connection set forth in claim 2, the same applies to claims 6 and 12.

Regarding claim 4 and the arguments applied to claims 8 and 11, it is not solely the maintenance of telephone communication between the remote structure sites with the structure sites, but what is important is that the computer is not necessary while there can be telephone usage. To avoid the large number of computers that would be required because of the telephone usage the present invention provides for an advance over the prior art.

With respect to the other independent claims, claims 5 and 9, these claims are also patentable for the reasons set forth heretofore in connection with claim 1.

The Examiner appears to be giving a great deal more weight to Skigin than it really deserves and is treating Skigin disclosure like a nose of wax to vary and change as the Examiner desires to fit the Examiner's rejection and is treating it in such a way that the Examiner wants to modify Skigin so that it can be combined with another reference to arrive at Applicant's claimed invention.

In Skigin, computer stations are provided in the circuit between the telephone sets and the network which then requires more additional firm wear as the number of users increases. The present invention overcomes this particular problem. The present invention proposes the use of network adapters to link computer networks at both transmitting and receiving ends. Further, multimedia soft wear can be provided to establish direct voice telephone communication. Moreover, the external computer network and the local computer network thus allows user call to be switched without requiring specialized switching devices. No multiplexer is necessary for the single telephone user. The only purpose for the bringing of Skigin et al. to the attention of the Patent and Trademark Office as prior art in the Application as filed is to indicate the possibility for an interface (telephone adapter) at this telephone site could be performed by the aforesaid Russian Patent, and it is for no other purpose. The local computer network at each site is provided with a router connected to the local computer.

The inventor has analyzed the arguments of the Patent Examiner with reference to figure 1 and figure 3 of JP 09098227 (Hiyama) and would like to draw attention of the Patent Examiner to the following facts.

1. The Patent Examiner directs that the Office Action is in response to amendment filed 8/29/2003. According to this amendment claims 1, 5 and 9 defines that “... each telephone set interface being connected directly to the bus of the local computer network; connecting computer....”

But this feature also, it is respectively submitted, should be further analyzed by the Examiner.

2. According to Hiyama (all figures) the telephone set interfaces (3a or 3b or 3c) are connected directly to the personal computer (105a or 105c or 105e) of local computer network. This is a clear distinction from the present invention.

The Abstract (Hiyama) contains the following sentence: "The packet sent to the Ethernet (R) IN is read by a 1st personal computer 105a...."

Thus, it is not possible without working personal computers (105) to phone each other by the telephone sets (1). Consequently, all of the claims structurally distinguish from the combination of reference of Hiyama and Skigin.

3. Regarding claims 1, 5 and 9, the Applicant is responding to the 5th Detailed action. The 1st and 2nd Detailed actions have used the reference to Baratz (US Patent 5,742,596). The Baratz reference was withdrawn, and the Examiner cited a new reference and at the same time issued a final action without providing for a non-final action.

The claimed invention differs from Hiyama because the claims set forth a telephone adapter and the capability of the telephony adapter together with a network adapter to provide for a connection to connect a telephone set directly to the bus of the local computer network connecting computers. In accordance with teachings of the invention the telephone allows calls from the telephone-computer or computer-telephone to be made. The use of the telephone sets is not limited by computers. According to the claimed invention it is possible without the use of the computers to phone each other through the telephone sets connected to the local computer network

The claimed invention and Hiyama decide the task to provide telephone communication through a local computer network by different ways. Hiyama has suggested using the personal (host) computers for it. The claimed invention teaches using and claims the adapters only, which are working independently from the personal computer. The claimed invention and Hiyama each have different possibilities for connection of the telephone sets. According to the claimed invention, the telephone set may be connected to any point of the local computer network. According to Hiyama the telephone set must be connected only to a personal (host) computer or telephony server which are connected to the local computer network. Positive effect of using the claimed invention consists in a more convenient connection of the telephone sets. It will increase if the local computer network occupies a lot of rooms of different divisions. In this case more probably using a telephone set without computer and necessary number of the telephone sets may be much more than number of the computers.

4. Regarding claims 3, 7 and 10, the Examiner states that Skigin discloses the telephone adapter of claimed invention. The Examiner states that the computer 9 and 15 of Skigin are processor units of telephone adapter (see Detailed actions page 4 line 5 and 11 of text). But computers 9 and 15 of Skigin are connected to computer network 9 (see Abstract). They are parts of the LAN.

Skigin does not teach nor suggest any adapter. Devices 3, 4, 5, 6, 7, 12, 13, 14, 16, 17 and 18 may complete an adapter, but it is not possible to state that the computer 9 or 15 is part of the adapter, or stated differently, it is not possible to state that the part of LAN is part of telephone set adapter's connect telephone set to LAN. It is not understood, and the Examiner is asked to explain his further position.

Skigin, Hiyama and Baratz have used computer of LAN to allow digital information exchange within the framework of common network protocols. The Applicant has delivered designated function from computer of LAN to telephone adapter.

The Applicant designated and disclosed Skigin in the Prior Art and uses some elements (devices) known from Skigin in the claimed invention. However, new elements and features are provided including a processor unit to provide digital information exchange within the framework of common network protocols. The processor has only one function. It is not computer of LAN.

5. Regarding claims 4, 8 and 11, the Examiner states that Hiyama discloses the processor unit (12, figure 3 is indicated by Examiner). But it is a personal computer, see Abstract of Hiyama).

A personal computer does include a processor unit. Also, the personal computer provides digital information exchange within the framework of common network protocols. But what element forming part of the personal computer provides this function? Hiyama, Skigin, and Baratz do not disclose such element.

In the claimed invention, the processor unit is an element of the adapter. This element has only one function, that is: to provide digital information exchange within the framework of common network protocols is provided.

If there are any points outstanding, the Examiner is respectfully asked to call Applicant's attorney in order to do what is necessary to place the Application into condition for allowance. The Applicant's attorney would appreciate a courtesy telephone

call to ascertain the Examiner's position on the present claims and the arguments submitted.

Early and favorable reconsideration, together with the allowance of this Application, is respectfully solicited.

If additional fees are needed, please charge them to our Deposit Account 10-0100.

Respectfully submitted,
LACKENBACH SIEGEL, LLP
Attorneys for Applicant(s)

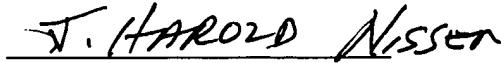
By:


J. Harold Nissen

Reg. No. 17283
Customer No. 28752
Telephone No.: 914-723-4300
Fax No.: 914-723-4301

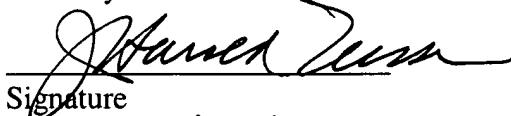
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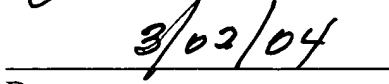


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